



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,688	04/13/2004	Mayumi Tomikawa	1075.1259	4798

21171 7590 09/24/2007
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

MIA, HASSEN A

ART UNIT	PAPER NUMBER
----------	--------------

2609

MAIL DATE	DELIVERY MODE
-----------	---------------

09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,688

Applicant(s)

TOMIKAWA ET AL.

Examiner

Hassen A. Mia

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4, 5, 6, 7, 9, 12, 20, 22, 23, 24, 26, 29, 35, 36, 37, 39, 40, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 3,8,10,11,13-19,21,25,27,28,30-34 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 2, 20 and 39 - 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiroshi Kobayashi, Publication number: Japan 05-284253; (hereafter refer Hiroshi),

Regarding claim 1, “(ORIGINAL) An electronic mail (e-mail) system that has: a first information terminal” (receiver side A, unit 2) “for transmitting and receiving sound information and text information; a second information terminal” (receiver side B, unit 2) “for transmitting and receiving sound information and text information in different ways; and a managing apparatus” (unit 1, in figure 1), “communicably interconnected between said first information terminal and said second information terminal” (receiver side B, unit 2), “for managing an e-mail message that includes at least text information to be transmitted and received between said first information terminal” (receiver side A, unit 2) “and said second information terminal” (receiver side B, unit 2), “said managing apparatus” (unit 1, in figure 1), comprising: reads on (figure 1, a switching network for document mail, and it connects the recording control unit 3 for documents for carrying out the recording storage of the transmitting documents temporarily to it while it connects two or more sets of the terminals 2 for document mail to this network 1, and it

Art Unit: 2609

constitutes the document e-mail system to it) Hiroshi Paragraph 0011 and paragraph 12.

"a text" (document) "information notifying unit" (unit 3) "for notifying said second information terminal" (receiver side B, unit 2) "of the text information included in the e-mail message", reads on Hiroshi paragraph 0028.

"a sound information" (voice message) "storing unit" (unit 6) "adapted to store sound information related to the e-mail message", reads on Hiroshi paragraph 0019; and

"a managing unit" (devices 3 and 6) "for managing association between the e-mail message and the sound information related to the e-mail message", reads on Hiroshi paragraph 21.

Regarding claim 2, "(ORIGINAL) an e-mail system as set forth in claim 1, wherein said managing further comprising:

"a telephone number" (selects at least one electronic mail addressed to the user and reached to a mail server) "selecting unit" (selection section 17) "for selecting a telephone number for use in handling the sound information related to the e-mail message transmitted from said first information terminal (receiver side A, unit 2) to said second information terminal "(receiver side B, unit 2), paragraph 0025 and paragraph 0026.

Regarding claim 20, "(ORIGINAL) An e-mail system as set forth in claim 2, wherein, if the e-mail message, transmitted from said first information terminal" (A side, unit 2) "to said second information terminal" (B side, unit 2), "has information added thereto about the sound information, said managing apparatus further comprises":

Art Unit: 2609

"a sound information obtaining" (telephone unit 5) "for obtaining the sound information based on the information, added to the e-mail message, about the sound information, said sound information obtaining" (telephone unit 5) "then storing the thus obtained sound information, as the sound information related to the e-mail message, to said sound information storing" (unit 6) reads on Hiroshi obtaining voice through telephone unit 5 and storing it at the accumulation control device unit 6, paragraph 0021.

a sound information reproducing unit for reproducing the sound information stored in said sound information storing unit; and

a sound replay unit for replaying the sound information, reproduced by said sound information reproducing unit, through said telephone number reads on Hiroshi, when the recipient lifts the telephone (5) handset, the voice message stored in the voice storage and control device (6) is read out and output to the telephone (5) via the telephone exchange network (4), paragraph 0029.

Regarding claim 39, "(ORIGINAL) A method for transmitting electronic mail (e-mail) message that includes at least text information to be transmitted and received between a first information terminal" (receiver side A, unit 2) "and a second information terminal" (receiver side B, unit 2), "which first information terminal transmits and receives sound information and text information, and which second information terminal" (receiver side B, unit 2) "transmits and receives sound information and text information in different ways, said method comprising the steps of":

"notifying said second information terminal" (receiver side B, unit 2) "of the text information included in the e-mail message," reads on Hiroshi paragraph 0028.

Art Unit: 2609

"storing sound information related to the e-mail message", reads on Hiroshi device 6 which is adapted to store voice related to the email paragraph 0019; and

"managing association between the e-mail message and the sound information related to the e-mail message," reads on Hiroshi accumulation units 3 and 6, paragraph 0021.

Regarding claim 40, "(ORIGINAL) An information processing apparatus, communicably interconnected between a first information terminal" (receiver side A, unit 2) "for transmitting and receiving sound information and text information and a second information terminal" (receiver side B, unit 2) "for transmitting and receiving sound information and text information in different ways, for managing an electronic mail" (e-mail) "message, including at least text information, transmitted and received between said first information terminal" (receiver side A, unit 2) "and said second information terminal" (receiver side B, unit 2), "said information processing apparatus comprising":

"a text information notifying unit" (temporary storage unit 3) "for notifying said second information terminal" (receiver side B, unit 2) "of the text information included in the e-mail message" reads on Hiroshi paragraph 0028;

"a sound information storing unit" (unit 6) "adapted to store sound information related to the e-mail message," reads on Hiroshi voice storage unit, paragraph 0021.

"a managing unit" (devices 3 and 6) "for managing association between the e-mail message and the sound information related to the e-mail message" reads on Hiroshi accumulation units 3 and 6, paragraph 0021.

Regarding claim 41, "(ORIGINAL) An electronic mail" (e-mail) "managing program which instructs a computer to function as an information processing apparatus, communicably interconnected between a first information terminal" (A side, unit 2) "for transmitting and receiving sound information and text information and a second information terminal" (receiver side B, unit 2) "for transmitting and receiving sound information and text information in different ways, for managing an e-mail message, including at least text information, transmitted and received between said first information terminal" (receiver side A, unit 2) "and said second information terminal" (B side, unit 2), "said information processing apparatus comprising":

"a text information notifying unit" (unit 3) "for notifying said second information terminal of the text information included in the e-mail message" reads on Hiroshi paragraph 0028.

"a sound information storing unit" (unit 6) "adapted to store sound information related to the e-mail message" reads on Hiroshi paragraph 0028; and

"a managing unit" (devices 3 and 6) "for managing association between the e-mail message and the sound information related to the e-mail message", read on Hiroshi accumulation units 3 and 6.

Regarding claim 42, "(ORIGINAL) A computer-readable recording medium storing an electronic mail" (e-mail) "managing program thereon, which program instructs a computer to function as an information processing apparatus, communicably interconnected between a first information terminal" (receiver side A, unit 2) "for transmitting and receiving sound information and text information and a second

Art Unit: 2609

information terminal" (receiver side B, unit 2) "for transmitting and receiving sound information and text information in different ways, for managing an e-mail message, including at least text information, transmitted and received between said first information terminal" (receiver side A, unit 2) "and said second information terminal" (receiver side B, unit 2) , said information processing apparatus comprising":

"a text information notifying unit" (unit 3) "for notifying said second information terminal" (B side, unit 2) "of the text information included in the e-mail message" reads on Hiroshi paragraph 0028.

"a sound information storing unit" (unit 6) "adapted to store sound information related to the e-mail message" reads on Hiroshi paragraph 0028; and

"a managing unit for managing association between the e-mail message and the sound information related to the e-mail message," read on Hiroshi accumulation units 3 and 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 7, 22 to 24, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hiroshi in view of Kawakami Yoshio Japan, Publication Number 10-335327, (hereafter refer Kawakami).

Art Unit: 2609

Regarding claim 4, "(CURRENTLY AMENDED) an e-mail system as set forth in claims 1, Hiroshi teaches managing apparatus, said sound information storing unit stores such sound information input from said reply sound (regenerate) input unit" (telephone 12) "as sound information related to the e-mail message" the electronic mail voice regenerative apparatus which can transmit a message in relation to the electronic mail pumped out of the audio terminal, paragraph 0011 and paragraph 0012.

Hiroshi does not teach reply sound input unit and reply to sound information however, Kawakami teaches "wherein said second information terminal includes a reply sound input unit" (telephone 12) "for inputting sound information, as a reply to the e-mail message" (replay message voice), "through an audio communication line specified by the telephone number acquires the mail address of the electronic mail", it can find out about the electronic mail addressed to itself from which it synthesized voice, paragraph 0003.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi electronic mail system by adding sound information reply as taught by Kawakami for faster reply.

Regarding claim 5, (ORIGINAL) an e-mail system as set forth in claim 4, Hiroshi does not teach "reply information is a reply e-mail message" however, Kawakami teaches "wherein said reply information is a reply e-mail message", (offering the electronic mail voice regenerative apparatus which can transmit a message in relation to the electronic mail pumped out of the audio terminal, paragraph 0004.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's electronic mail system by adding a reply e-mail system in relation with the received message as taught by Kawakami to save time especially in a critical situation.

Regarding claim 7, (ORIGINAL) An e-mail system as set forth in claim 5, Hiroshi does not teach "reply e-mail message has a pointer" however, Kawakami teaches reply e-mail message has a pointer for use in accessing a section of said sound information storing unit in which section said sound information is stored", (an electronic mail selection means to choose at least one pair in the electronic mail which addressed to said calling party and has a received a message, paragraph 0013.

It would have been obvious to one of the ordinary skills of the art at the time of the invention to modify Hiroshi's electronic mail system by adding a pointer as taught by Kawakami to expedite the response to an email by choosing the desired address.

Regarding claim 22, (CURRENTLY AMENDED) An e-mail system as set forth in claim 20, Hiroshi does not teach "apparatus prepares, based on the association managed by said managing" however, Kawakami teaches "managing apparatus prepares, based on the association managed by said managing unit reproduction information, as a reproduction information notification e-mail message, that an e-mail message which is addressed to said second information terminal, and to which information about sound information is added, has been received from said first information terminal" (a notification electronic mail message generating a part (20) generates an electronic mail message that includes in its content the telephone number

Art Unit: 2609

and response message identifying information, here the mail message is called a notification electronic mail message), paragraph 0007.

It would have been obvious to one of the ordinary skills of the art at the time of the invention to modify Hiroshi's electronic mail system and especially the storage unit (19) by making it a multifunctional circuit as taught by Kawakami to minimize cost.

Regarding claim 23, (ORIGINAL) an e-mail system as set forth in claim 22, Hiroshi does not teach "telephone number selected by said telephone number selecting unit" however, Kawakami teaches "reproduction information notification e-mail message includes said telephone number selected by said telephone number selecting unit" (selection section 17), (see solution and figure 1).

It would have been obvious to one of the ordinary skills of the art at the time of the invention to modify Hiroshi electronic mail system and specially the storage unit (19) by making it a multifunctional circuit as taught by Kawakami to minimize cost.

Regarding claim 24, (ORIGINAL) an e-mail system as set forth in claim 22, Hiroshi does not teach "telephone number selected by said telephone number selecting unit" however, Kawakami teaches "reproduction information notification e-mail message has a pointer for use in accessing information indicating said telephone number selected by said telephone number selecting unit", (the reply message specific information in its message content), see solution figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's electronic mail system by adding a pointer as taught by Kawakami, whereby the user can reply to the email by choosing the desired address.

Art Unit: 2609

Regarding claim 26, (CURRENTLY AMENDED) an e-mail system as set forth in claim 21, Hiroshi does not teach telephone number selected by said telephone number selecting unit however, Kawakami teaches wherein, of said managing apparatus said text information notifying unit prepares a notification e-mail message that contains the text information to be notified to said second information terminal;

said telephone number selecting unit selects a sound reproduction phone number for use in reproducing sound on said second information terminal, and

“said telephone number notifying unit adds information about the sound reproduction phone number” (for a device to transmit the phone number information showing the response message specific information contained in the electronic mail.), which is selected by said telephone number selecting unit, to the notification e-mail message, which is prepared by said text information notifying unit, paragraph 0010.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's electronic mail system by adding notification e-mail message, which is prepared by said text information notifying as taught by Kawakami, to eliminate the use of other circuits to do the same functionality, which lowers the cost.

Regarding claim 29, (CURRENTLY AMENDED) an e-mail system as set forth in claim 26, Hiroshi does not teach “telephone number selected by said telephone number selecting unit” however, Kawakami teaches “information about the sound reproduction phone number is the sound reproduction phone number itself” (for a device to transmit the telephone number information showing the response message specific information

Art Unit: 2609

contained in the electronic mail for advice to receive and the predetermined telephone number to said response message voice, sending – out is included, paragraph 0010).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's electronic mail system by adding telephone number selecting functionality on the telephone number selecting unity as taught by Kawakami, to eliminate the extra cost in order to acquire this functionality.

Claims 6, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hiroshi in view of Kawakami and further over Okada et al. US Patent No. 6463134, (hereafter refer Okada).

Regarding claim 6, (ORIGINAL) An e-mail system as set forth in claim 5, Hiroshi and Kawakami do not teach reply e-mail message has the sound information attached however, Okada teaches reply e-mail message" (the reply mail reparation center 27 receives the reply mail) "has the sound information attached thereto, which has been received from said second information terminal and then stored in said sound information storing unit", col. 12, lines 61 – 64 and col. 13, lines 1 – 8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's and Kawakami's system by attaching sound information on the reply message to make it more flexible and attractive to the consumer in addition, it will be easily used by the impaired people.

Regarding claim 9, (CURRENTLY AMENDED) an e-mail system as set forth in claims 4, Hiroshi and Kawakami do not teach reply sound input unit and reply to sound information however, Okada teaches managing apparatus, said text information

Art Unit: 2609

notifying unit (21) prepares a notification e-mail message that contains the text information to be notified to said second information terminal (40), (mobile telephone communication section 41 receives the incoming call from the portable telephone and store it temporarily), col. 14, lines 40 –50; and

said telephone number selecting unit (18) selects a sound input phone number for use in inputting sound from said second information terminal (40); and said telephone number notifying unit (21) adds information about the sound input phone number, which is selected by said telephone number selecting unit (18), to the notification e-mail message, which is prepared by said text information notifying unit (21), col.13, lines 1 – 8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's and Kawakami's electronic mail system by receiving an incoming call, storing it temporarily and send a text information as taught by Okada to make it cost effective since text messaging was very cheap.

Regarding claim 12, (CURRENTLY AMENDED) an e-mail system as set forth in claim 9, Hiroshi and Kawakami do not teach information about the sound input phone number is said sound input phone number itself however, Okada teaches information about the sound input phone number is said sound input phone number itself (receives the file and the mail ID from voice mail server), col. 13, lines 1 – 8, figure 15.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi's and Kawakami's system by integrating sound input phone

Art Unit: 2609

number into the phone and reduce the cost rather than building an external device to do that.

Claims 35, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Okada.

Regarding claim 35, (CURRENTLY AMENDED) An e-mail system as set forth in claim 1, Hiroshi does not teach "an identification information" however, Okada teaches "an identification information setting unit for providing, if there are a plurality of such e-mail messages or if there are a plurality of such sound information items related to the individual e-mail messages, the individual e-mail messages or the individual sound information items with identification information for identifying the e-mail messages or the sound information items, said managing unit managing association among the e-mail messages and the sound information items related to the e-mail messages and the identification information provided by said identification information setting unit , read on Okada electronic mail from the personal computer in the internet to the portable telephone for requesting the user of the portable telephone to make reply of yes/no in the first embodiment of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi electronic mail system by adding identification information to track the relating messages as taught by Okada to make it reliable system.

Regarding claim 36, (ORIGINAL) An e-mail system as set forth in claim 35, Hiroshi does not teach "an identification information inputting unit" however, Okada teaches "an identification information inputting unit for inputting such identification

Art Unit: 2609

information" (description) "so as to specify the e-mail message or the e-mail-related sound information corresponding to the input identification information", (the operation description section 36 inquires of the electronic mail display section 32 the input key information received from the key input section 34), col. 13 lines 21 - 37.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi electronic mail system by adding sound guidance as taught by Okada to make it more appealing for the users.

Regarding claim 37, (CURRENTLY AMENDED) An e-mail system as set forth in claim 1, Hiroshi does not teach sound guidance however, Okada teaches further comprising a sound guidance unit (24) for providing a user of said second information terminal (40) with guidance by voice, (after the call is established the voice mail server communication section 37 transmits the voice response to the voice mail server 40), col. 13, lines 32 - 39.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hiroshi electronic mail system by adding sound guidance as taught by Okada to make it easy for a blind person to use.

Allowable Subject Matter

Claim 3, 8, 10, 11, 13 – 19, 21, 25, 27, 28, 30 – 34 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Art Unit: 2609

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassen A. Mia whose telephone number is 571-272-9749. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST alt. Friday off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HM



BRIAN TYRONE PENDLETON
SUPERVISORY PATENT EXAMINER